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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,630	06/03/2005	Louis-David Cantin	5150	4617
<div>35969 7590 07/31/2008</div> <div>Barbara A. Shimei Director, Patents & Licensing Bayer HealthCare LLC - Pharmaceuticals 555 White Plains Road, Third Floor Tarrytown, NY 10591</div>				
EXAMINER				
BIANCHI, KRISTIN A				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
07/31/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,630

Applicant(s)

CANTIN ET AL.

Examiner

KRISTIN BIANCHI

Art Unit

1626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/07/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 14-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 10-13 and 37-40 is/are rejected.
- 7) ☒ Claim(s) 3-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
Paper No(s)/Mail Date 06/03/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-40 are pending in the instant application. Claims 14-36 are withdrawn from further consideration pursuant to 37 CFR § 1.142(b) as being drawn to non-elected inventions. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference which anticipates one group would not render obvious the other. Claims 1, 2, 10-13, and 37-40 are rejected and claims 3-9 are objected.

Priority

This application claims benefit of PCT/US03/40842 filed on December 19, 2003, which claims benefit of US Provisional Application No. 60/435310 filed on December 20, 2002.

Information Disclosure Statement

The information disclosure statement filed on June 3, 2005 was considered and a signed copy of form 1449 is submitted herewith.

Election/Restrictions

Applicant's election with traverse of the group wherein L-Y-(CH₂)_n-X- and Ar is phenyl optionally substituted at any available position by 1 to 5 independently selected R³ groups in the response filed on July 7, 2008 is acknowledged.

The traversal is on the ground(s):

"A search for the compounds of the elected group would necessarily result in discovery of any compositions comprising such compounds, or any methods of treatment utilizing

Art Unit: 1626

such compounds. Indeed, the search and examination of the compounds and their related methods of use would likely be co-extensive and, in any event, would involve such interrelated art that the search and examination of the both groups can be made without undue burden on the Examiner."

This is not found to be persuasive. The search for the product as claimed is not coextensive with the search for the process of using the product. For example, in regards to the instant election (i.e. compounds of Formula (I) wherein $L-Y-(CH_2)_n-X-$ and Ar is phenyl optionally substituted at any available position by 1 to 5 independently selected R^3 groups), a separate search would be required to determine the totality of the prior art that may exist that anticipates and/or makes obvious the methods of treatment with the compounds.

Upon further consideration, Groups I-IX have been rejoined (i.e. the compounds and compositions of Formula (I) have been examined in their totality) and are hereby referred to as Group I. Group I is still considered to be a different invention (i.e. for the reason given above) than the claims to the methods of treatment (now Group II). This restriction requirement is still deemed proper and is hereby made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 10-13, 37, 38, and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Lowe et al. (US 6,828,335, Dec. 7, 2004).

Lowe et al. discloses compounds, such as a compound of formula III (page 37) wherein R is hydrogen, R¹ is CH₃, R² is hydrogen, R⁵ is hydrogen and R⁷ is PhCH₂ (Compound No. 12, Table 2, page 38), which are useful in the treatment of diseases such as diabetes, obesity, hyperlipidemia, and atherosclerotic diseases (i.e. the compounds are used in pharmaceutical compositions or medicaments comprising an effective amount of a compound in combination with a pharmaceutically acceptable carrier and one or more pharmaceutically acceptable agents).

Compound No. 12 anticipates a compound of the instant claims wherein R¹ and R² are H or C₁-C₆ alkyl, L is -(CH₂)_m-X-, X is O, m is 1, and Ar is phenyl.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 39 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 39 is drawn to the use of compounds of claim 1, but since the claim does not set forth any steps, it is unclear what the method/process which the Applicant is intending to encompass actually is. A claim is indefinite when it merely recites a use without any active steps delimiting how this use is actually practiced. *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *ClinicalProducts, Ltd. V. Brenner*, 255 F. Supp. 131,149 USPQ 475 (D.D.C. 1966).

Claim Objections

Claims 3-9 are objected to for depending on a rejected base claim.

Conclusions

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTIN BIANCHI whose telephone number is (571)270-5232. The examiner can normally be reached on Mon-Fri 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamal A Saeed, Ph.D./
Primary Examiner, Art Unit 1626

Kristin Bianchi
Examiner
Art Unit 1626
